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08/858389

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/858,389 05/19/97 FOERSTER

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EXAMINER

KOO, B

ART UNIT

PAPER NUMBER

3764

DATE MAILED:

02/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/858,389

Applicant(s)

Seth A. Foerster et al.

Examiner

Benjamin Koo

Group Art Unit

3764



☒ Responsive to communication(s) filed on Nov 23, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 6, 15-17, 35-37, and 43-45 is/are pending in the application.

Of the above, claim(s) 6 is/are withdrawn from consideration.

☒ Claim(s) 17 is/are allowed.

☒ Claim(s) 1, 15, 16, 35-37, 43, and 44 is/are rejected.

☒ Claim(s) 45 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's amendment to claim 6 is moot since claim 6 was previously withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 11.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 15, 16, 35-37, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya, Kirsch et al. '240, and Miller et al. '269. Komiya shows a device comprising: a discrete marker element (11), a deployment actuator connector (10), a deployment actuator connector (19), a forming die (21), the marker element being able to travel along the tube, and a mandrel (20), but does not show the cutting tip and the predetermined failure point. Komiya further describes the use of known delivery apparatuses, such as endoscopes, to place the device into proper position (column 2, lines 47-49). Applicant's summary discloses that the delivery apparatus may be any known type such as a tube, needle, cannula, trocar, etc... Miller et

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al. shows an implantable tissue marking device using a delivery apparatus which incorporates a needle or cutting edge. It would have been obvious to have used a needle as taught in Miller et al. because such a variation is an obvious art-recognized alternative, as even disclosed by the applicant, to serve the purpose of placing the marking device in the proper location in the body. Kirsch et al. shows a deployment actuator having a predetermined failure point. It would have been obvious to have used the deployment means of Kirsch et al. because both types would be considered art-recognized alternative structures. Both incorporate bendable marker elements which are similar in shape, but use different styles of deployment means, one using a notch, one breaking the marker off. Limitations drawn to various marker shapes or sizes are considered obvious choices of design based on user preference to suit a particular need or application.

***Allowable Subject Matter***

4. Claim 17 is allowed.
5. Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not show a vacuum used to isolate and retain tissue at the selected location in order for the marking device to implant a marker element which the tissue is being retained.

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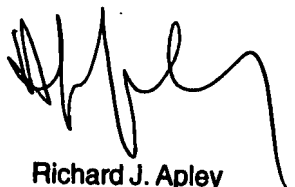
7. Any inquiry concerning the specifics of this communication should be directed to Examiner Ben Koo who can be reached M & W-F from 9:30 am to 6:00 pm. Inquiries of a general nature should be directed to the Technology Center 3700 receptionist. Official responses can be filed 24 hours a day to the Official fax number listed below, subject to the provisions of 37 C.F.R. 1.6(d). Unofficial faxes which are meant for discussion purposes only should be sent to the Unofficial Fax number below; it is strongly suggested that the Examiner be contacted directly before sending any Unofficial Fax.

Contact numbers:

Examiner Koo	703-308-2657
Receptionist	703-308-0858
Official Fax	703-308-0758
Unofficial Fax	703-306-4520

bk

February 12, 2000

  
**Richard J. Apley**  
**Supervisory Patent Examiner**  
**Group 3700**